REMARKS

In the Office Action mailed October 3, 2005, the Examiner considered claims 1-4, 6, 9-14, and 16-24. Of these, the Examiner allowed claims 1-4, 6, 14, 16, and 18-22; rejected claims 9, 11, 17, and 24; and objected to claims 10, 12-13, and 23. For the reasons set forth below, the Applicants respectfully request that the Examiner reconsider the rejections and allow all the pending claims.

Amendments to the Specification:

The specification has been amended as shown earlier to correct typographical errors and/or minor mistakes. These amendments do not result in the addition of new matter.

Section 103 Rejections

Claims 9, 11, 17, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the journal article entitled "Application of Compaction Technique to Optimizing Wireless Email Transfer" by Chan et al. ("*Chan*") in view of U.S. Patent No. 6,052,735 to Ulrich et al. ("*Ulrich*").

With respect to independent claim 9, the Applicants submit that neither *Chan* nor *Ulrich*, either singly or together, disclose or suggest the elements of claim 9. More specifically, the Applicants submit that *Chan* does not disclose or suggest "retrieving and storing into the memory only a second hierarchical level of information corresponding to the at least one of the data items" as recited in claim 9. On pages 2-3 of the Office Action, the Examiner seems to argue that the object "o" that is encoded on the server side and later decoded on the client side (specifically, the Examiner refers to *Chan* at page 1534, Section III 3rd paragraph lines 10-21) corresponds to the "second hierarchical level of information". However, the encoded/decoded object is not a "second hierarchical level of information" since the encoded/decoded object is the entire e-mail message (i.e., encoded/decoded object) rather than a portion of it. Support for this assertion that the entire e-mail message is transferred from the server to the client is provided throughout *Chan*. For example, section IV page 1537 1st paragraph states that during the

encoding/decoding stage, for client-to-server transfer, "[t]he compression ratio is expected to be lower in this direction because of the absence of message headers which are highly redundant"; this indicates that the transfer of an e-mail message from the server to the client is of the entire message (not just the message body) including the message header. Combining *Chan* with *Ulrich* does not cure this deficiency.

In addition, Applicants submit that the Examiner has not established a prima facie case of obviousness since the Examiner has not provided an adequate suggestion to combine *Chan* with *Ulrich*. The Examiner has the burden of showing that the cited references provide a suggestion to combine them. *See, e.g.,* MPEP 2142. If the resulting apparatus is unsatisfactory for its intended purpose, then there is no suggestion or motivation to combine the references. *See, e.g.,* MPEP 2143.01. On page 3 of the Office Action, the Examiner argues that the combination of *Ulrich* and *Chan* discloses retrieving and storing into the memory only a third hierarchical level of information. *Ulrich* discloses enabling a mobile device to dynamically retrieve from a desktop computer individual e-mail attachments. On the other hand, *Chan* discloses a compaction scheme to reduce the amount of data transferred over a wireless link such as, e.g., a link between a server and a client. *Chan* does not disclose a hierarchical scheme; however, assuming arguendo that it does, then if the e-mail attachment of *Ulrich* is transferred using the *Chan* compaction scheme, then there is no reduction in the size of the encoded object transferred because the cache stores e-mail messages rather than e-mail attachments and thus there would be no similarity between the attachment transferred and the reference objects selected. Because there would be no reduction in the size of the encoded attachment transferred using the *Chan* scheme, the resulting system is unsatisfactory for its intended purpose of reducing the size of the transferred object, and thus there is no motivation to combine *Chan* with *Ulrich*.

For at least these reasons, Applicants respectfully request reconsideration and allowance of claim 9. Claims 11, 17, and 24 depend from claim 9. Accordingly, they are patentable over the combination of the cited references at least for the reasons set forth above with respect to claim 9.

New Claims

New claims 25-27 depend from claim 1. The Examiner allowed claim 1 in the Office Action mailed October 3, 2005. Therefore, new claims 25-27 are allowable.

New claims 28-29 depend from claim 9. Thus, claims 28-29 are patentable over the proposed combination of *Chan* and *Ulrich* for at least the reasons provided earlier with respect to claim 9. Therefore, the Applicants respectfully request allowance of new claims 28-29.

New claims 30-37 include the element of a "second hierarchical level of information". For the reasons provided earlier with respect to claim 9, the Applicants assert that the proposed combination of *Chan* and *Ulrich* does not disclose or suggest the "second hierarchical level of information". Therefore, the Applicants respectfully request allowance of new claims 30-37.

CONCLUSION

On the basis of the above remarks, reconsideration and allowance of all the pending claims is believed to be warranted and such action is respectfully requested. If the Examiner has any questions or comments, the Examiner is respectfully requested to contact the undersigned at the number listed below. The Office is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1847.

Respectfully Submitted,

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